

## **REMARKS**

Claims 1, 7-8, and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tahitian Noni Products (<http://www.noni-now.com>, copyright 1998 – 2003) in view of JP 2000-095663 to Kondo et al. in further view of U.S. Patent Serial No. 6,224,888 (“Vatter”); claims 1, 7-8, 11-12, 22 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Morinda, Inc. Lip Balm in view of Fisher (Living Better, Vol. 1(5) 1998) in further view of Kondo and Vetter; claims 1, 7-8, 11, and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kondo et al., in view of Elkins (Hawaiian Noni, 1998) and Vatter; and Claims 1, 7-8, and 27 are rejected under the judicially created doctrine of obviousness – type double patenting as being unpatentable over claims of U.S. Patent No. 6,589,414.

### **Claim Rejections Under 35 U.S.C. § 103**

At least for the reasons set forth below, Applicant submits that the relevant prior art fails both teach or suggest all the claim limitations, and to clearly and particularly suggest the combination indicated by the Examiner; thus, Applicant’s claims are not obvious in view of the prior art references.

#### **1. Rejection Under noni-now.com and Morinda, Inc.**

Attached please find the Statutory Declaration of Jarakae Jensen and Heidi Robinson, both inventors of the presently filed application in which Declarations Heidi and Jarakae declare the contents of the present application were conceived and reduced to practice prior to the publications referenced on Noni-Now.com and by Morinda, Inc.

Also attached please find unsigned Declarations by Tim Osterholm and Michael Drake. Both parties have signed the documents and have mailed them to our office and we will forward them to you in a supplemental amendment to follow. As indicated in the attached Declarations, Michael Drake declares that the products sold by Noni-Now.com and Morinda, Inc. are products

manufactured by Morinda, Inc., and that the invention disclosed and claimed in the above-referenced application was conceived and reduced to practice prior to the referenced Noni-Now.com and Morinda products being manufactured and sold by Morinda, Inc. or by Noni-Now.com as evidenced by the contents of Exhibit "A" attached Michael Drake's declaration, which contain the final approval for manufacture of the referenced product.

As indicated in the attached Declaration, Tim Osterholm declares that the products sold on his website, Noni-Now.com, at the time of the publication of the cited reference are the products manufactured by the Applicant. Additionally, Tim declares that the e-mail attached as Exhibit "B" contains inaccurate information. Specifically, the lip balm in question was not sold or otherwise made available to the public in 1999.

Because the Noni-Now.com and Morinda, Inc. publications both reference products sold by the Applicant, wherein the Applicant had reduced to practice the invention prior to publication, the rejections under Noni-Now.com and Morinda, Inc. are inappropriate. Because Noni-Now and Morinda, Inc. alone or in combination with the other cited references do not teach or suggest every element of the present claims, the present invention is not obvious over the combination.

## **2. Kondo by itself or in view of Elkins and Vatter**

The Examiner has rejected claims 1, 7-8, 11 and 27 under 35 U.S.C. 103(a) as being unpatentable over Kondo in view of Elkins. Applicant has amended claim 1 to include the limitations found in dependent claim 12 and thus the present invention is not obvious over the combination.

**Double Patenting**

Enclosed please find a terminal disclaimer in compliance with 37 C.F.R. 1.321(c) executed by a registered attorney for the applicant. Applicant respectfully submits that the terminal disclaimer overcomes the obviousness-type double patenting rejection.

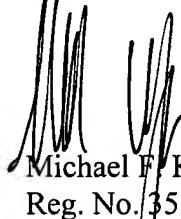
**CONCLUSION**

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

Dated this 30 day of January, 2006.

Respectfully submitted,

KIRTON & McCONKIE



Michael F. Krieger  
Reg. No. 35,232

Kirton & McConkie  
1800 Eagle Gate Tower  
60 East South Temple  
P.O. Box 45120  
Salt Lake City, Utah 84111-1004  
Telephone: (801) 328-3600  
Fax: (801) 321-4893

JRM/sp  
Doc#826076